

### **REMARKS**

The present Amendment is in response to the Office Action mailed March 6, 2006. Claims 1, 11-12, 14, and 21 are amended. Claims 1-26 are now pending in view of the above amendments.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

#### **Examiner's Interview**

Applicant's express their appreciation to the Examiner for conducting an interview with Applicant's representative on March 28, 2006. This response includes the substance of the interview.

#### **Rejections Under 35 U.S.C. § 103**

The Office Action rejected claims 1, 2, 5-17, and 19-26 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,283,761 (Joao) in view of U.S. Patent 6,343,271 (Peterson). Claims 3 and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Joao and Peterson in view of Robinson-Crowley, Christine ("Understanding Patient Financial Services") (Robinson). Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Joao, Peterson, and Robinson in view of U.S. Patent No. 5,070,452 (Doyle).

As noted in Applicant's specification, a carrier receives and reviews millions of requests for the payment of insurance claims for health care service. The sheer volume of requests can create a backlog of unpaid claims. The time delay caused by this backlog can be increased when

the carrier requires supporting documents before adjudicating the claims because the request for the supporting documents is often made a few days or weeks after the health care provider filed the original insurance claim.

In contrast to conventional systems, embodiments of the invention relate to delivering electronic versions of supporting documents, thereby enabling the claim to be adjudicated in a more timely manner. Further, payment for the claims can be advanced prior to adjudication by the carrier.

As discussed at the interview regarding the claims, the Office Action contends that Joao teaches:

- (1) receiving an insurance claim from the client system; and
- (2) notifying the carrier that an electronic image of the supporting document is available to the enable the carrier to process the insurance claim.

At the same time, the Office Action acknowledges that Joao fails to disclose:

- (3) receiving a supporting document associated with the insurance claim in an electronic format from the client system

One of the basic considerations applied when applying 35 U.S.C. § 103 is that the claimed invention must be considered as a whole. *See* MPEP § 2141.01. Applicant assert that the Office Action fails to consider the claim as a whole. As discussed at the interview, for example, because Joao fails to disclose (3), Joao cannot disclose at least (2). When considering the claim as a whole, it is inconsistent to teach that an electronic image of the supporting document is available if Joao fails to disclose receiving the supporting document. In other words, one cannot notify the availability of a supporting document that was not received. Considering the claim as a whole, Joao cannot teach or suggest “notifying the carrier that an electronic image of the supporting document is available” if Joao fails to disclose “receiving a supporting document . . .”.

The Office Action further contends that (2) above is taught when Joao states that “[t]he apparatus and method of the invention can utilize electronic commerce technologies and security methods, techniques and technologies, in any and/or all of the instances of data and/or information processing, and/or data and/or information transmission described herein” (*see col.*

4, lines 6-11). This passage, however, fails to consider the claim as a whole and merely recites electronic commerce technologies without disclosing what is being sent.

As further discussed at the interview, the claim 1 requires both an insurance claim and a supporting document. For example, claim 1 requires receiving an insurance claim. Next, claim 1 has been amended to require identifying a supporting document with the insurance claim based on information include in the insurance claim. Thus the supporting document is distinct from the insurance claim. Joao, however, only discusses an insurance claim and does not teach or suggest identifying a supporting document to be submitted with the insurance claim or transmitting a request for the supporting document as required by claim 1.

The Office Action cited Peterson as teaching (3), which was not disclosed by Joao. A review of the text cited by the Examiner reveals that Peterson does not contemplate both an insurance claim and a supporting document. More particularly, the invention of Peterson relates to "claims processing systems that allow health care providers to electronically submit insurance claims for payment." *See* col. 3 line 66- col. 4, line 1. This processing system allows medical benefits to be accessed or changed on-line. However, Peterson discloses that the health care provider can access, download, or print a partially prepared claim or diagnosis form and that patient and treatment information is submitted in the insurance claims. *See* col. 4, lines 6-20.

However, claim 1 requires:

- receiving an insurance claim from the client system;
- identifying a supporting document to be submitted with the insurance claim based on information included in the insurance claim;
- transmitting a request to the client system for the supporting document;
- receiving the supporting document associated with the insurance claim in an electronic format from the client system;
- storing the supporting document in a database; and
- notifying the carrier that an electronic image of the supporting document is available to enable the carrier to process the insurance claim.

As discussed at the interview, while either Joao or Peterson may disclose receiving an insurance claim, the disclosure of both Joao and Peterson is limited to the insurance claim. No teaching is present, as indicated in the Interview Summary, of identifying a supporting document to be submitted with the insurance claim based on information in the insurance claim. While Joao and Peterson each teach that an insurance claim can be submitted electronically, there is no

suggestion that supporting documents needed to process the claim are identified for the client system. Because the requirement of identifying the supporting document is not taught or suggested by the cited art, the requirements of “transmitting a request to the client system” and of “receiving the supporting document” and of “storing the supporting document” are likewise not taught or suggested by the cited art.

For at least these reasons and as discussed at the interview, claim 1 is not taught or suggested by the combination of Joao and Peterson.

For similar reasons, claims 14 and 21 are not taught or suggested by the cited art. As discussed above, claim 14 also requires both an insurance claim and a supporting document. In claim 14, the client system identifies the supporting document while displaying the claim form. This clarifies that the supporting document can be identified and electronically submitted at about the same time that the insurance claim is prepared. In other words, the supporting document can be identified while the insurance claim is being prepared, rather than identified days or weeks after the claim is submitted. Further, claim 14 requires converting the supporting document into an electronic format. As discussed at the interview and when considering the claim as a whole, converting the supporting document (which has been identified as required for processing the insurance claim) into an electronic format is not taught or suggested by the cited art.

Similarly claim 21 requires both an insurance claim and a supporting document. While both Joao and Peterson relate to submitting an insurance claim, neither Joao or Peterson teach the method of processing an insurance claim as required in claim 21. For example, after receiving an insurance claim and receiving a notice of the accessibility of an electronic image of a supporting document, claim 21 requires accessing the electronic image. Then, claim 21 requires adjudicating the insurance claim based on the information in the insurance claim and on the information include in the electronic image of the supporting document. Finally, claim 21 requires making payment on the claim to an entity that advanced payment. As discussed above, neither Joao or Peterson disclose that a supporting document is identified and provided in electronic format. As a result, Joao and Peterson cannot disclose the requirement in claim 21 of “receiving a notice indicating the accessibility of an electronic image of a supporting document”. Further, the requirement of “adjudicating the insurance claim based on information in the

insurance claims and in the electronic image of the supporting document” is not taught by the cited art.

For at least these reasons and as memorialized in the Interview Summary, Applicant respectfully submits that claims 1, 14, and 21 are in condition for allowance. Because claims 1, 14, and 21 are in condition for allowance, the dependent claims 2-13, 15-20, and 22-26 also overcome the art for at least the same reasons.

### **Conclusion**

In view of the foregoing, and consistent with the Examiner Interview, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 2<sup>nd</sup> day of May 2006.

Respectfully submitted,



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